Remarks

The non-final Office Action dated April 9, 2009 lists the following rejections: claim 13 stands rejected under 35 U.S.C. § 112(1); claim 13 stands rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter; claims 1-3, 6-7, 10 and 12-17 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Suzuki (EP 1 046 983) in view of Faraboschi (U.S. Patent 5,930,508); and claims 8-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Faraboschi as applied to claim 1, and further in view of Iwata (US Pat No. 6,275,921) and Topham (US Patent Pub. 2001/0047466). In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 103(a) rejections because the '983 reference teaches away from the Office Action's proposed modification. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a §103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('983) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.").

In this instance, the Examiner proposes to combine teachings of the '508 reference directed to sets of dispersal bits and delimiter encoding bits (*see, e.g.,* Col. 5:12-18) with the combined instruction sequence of the '983 reference (*see, e.g.,* Paragraph 0045). Applicant submits that such a modification would undermine the '983 reference's stated purpose of providing a VLIW processor capable of processing a compressed program "without assigning special bits to an instruction field." *See, e.g.,* paragraph 0017. As such, the Examiner's proposed modification of adding dispersal bits and delimiter encoding bits, which are expressly taught by the '508 reference as being added to each instruction word (*see, e.g.,* Col. 4:57-60 and Col. 5:12-18), would directly undermine the '983 reference's purpose of not assigning special bits to an instruction

field thereby rendering the '983 reference unsatisfactory for its intended purpose. In other words, there is no motivation for the skilled artisan to combine the '508 reference's "special bits" with the '983 reference's compression scheme because the '983 reference expressly teaches avoiding techniques such as those taught by the '508 reference (*i.e.,* the '983 reference teaches away).

In a failed attempt to maintain the rejections, the Examiner (on page 9 of the instant Office Action) asserts that the teachings of the '508 reference do not undermine the teachings of the '983 reference because the '508 reference "simply offers another design option and discusses the benefits of using that option." The Examiner's assertions continue to ignore the express teachings of the '983 reference. Specifically, the Examiner's assertions regarding the alleged benefits of the technique taught by the '508 reference do not address the fact that the '983 reference expressly teaches not to use techniques such as those taught by the '508 reference, as discussed above. As such, there is no motivation for the skilled artisan to use the technique taught by the '508 reference because that technique does not "suit the needs of the system" of the '983 reference. In other words, the technique taught by the '508 reference is a "design option" that the '983 reference expressly teaches not to use.

In view of the above, the § 103(a) rejections are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections because the cited combination does not correspond to aspects of the claimed invention directed to adding control information to the single instruction word that indicates a sequential order of the first and at least second individual instructions at their respective functional units. The Examiner acknowledges that the '983 reference does not teach or suggest such aspects. In a failed attempt to address this deficiency, the Examiner erroneously asserts that the delimiter encoding bits of the '508 reference indicate a sequential order of each syllable of the compacted instruction. In actuality, the '508 reference's delimiter encoding bits simply indicate the boundaries between compacted instructions that are themselves in sequential order. *See, e.g.,* Col. 5:12-18. As such, these delimiter encoding bits do not indicate the sequential order of the instructions, but merely indicate the boundaries between instructions that are already in sequential order.

In the instant Office Action (*see* page 9), the Examiner continues to misconstrue the teachings of the '508 reference as corresponding to the claimed invention. The delimiter encoding bits of the '508 reference do not, by themselves, provide any indication of the sequential order of the instructions, as does the control information of the claimed invention. In other words, if the instructions of the '508 reference were not stored in sequential order, one would not be able to determine the sequential order of the instructions from the delimiter encoding bits. Instead, the delimiter encoding bits are simply used "to indicate the point at which one instruction ends and the next begins." *See, e.g.,* page 9 of the instant Office Action. Thus, the delimiter encoding bits do not correspond to the control information of the claimed invention. Because neither reference teaches such aspects, no reasonable combination of these references can provide correspondence. Accordingly, the § 103(a) rejections are improper and Applicant requests that they be withdrawn.

Applicant respectfully traverses the § 112(1) rejection of claim 13 because the rejection is impermissibly based upon an assertion that the specification must recite word-for-word correspondence to the claim limitations. Applicant submits that "[t]he written description requirement does not require the applicant "to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed. "'' *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989 (Fed. Cir. 2000), *cert. denied*, 69 U.S.L.W. 3165 (Feb. 20, 2001) (No. 00-249) (quoting *In re Gosteli*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1989). In addition, the Examiner has not met the initial burden of a thorough reading and evaluation of the application and has presented neither sufficient evidence nor sufficient analysis/reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claim term computer readable medium. *See, e.g.,* M.P.E.P. § 2163. Notwithstanding the fact that the Examiner has failed to meet the initial burden required for a § 112(1) rejection, in the previous Response Applicant provided the Examiner with specific examples of where support for a transaction document rating engine can be found in Applicant's disclosure. For example, paragraph 0055 of Applicant's specification discusses a computer program being stored on a storage medium such as a floppy disk or

a CD-ROM. In response to Applicant's explanation, the Examiner continues to simply conclude that there is no support apparently based on the erroneous assertion that the specification must recite word-for-word correspondence to the claim limitations. The Examiner continues to have presented neither sufficient evidence nor sufficient analysis/reasons why a person skilled in the art would not recognize that the term computer readable medium is supported by Applicant's disclosure. Accordingly, the § 112(1) rejection of claim 13 is improper and must be withdrawn.

Notwithstanding, in an effort to facilitate prosecution, Applicant has amended claim 13 to recite a computer readable storage medium. Applicant believes that this amendment is not necessary for patentability and further, that the scope of claim 13 has not changed. In view of the amendment, Applicant believes that the § 112(1) and § 101 rejections of claim 13 are no longer applicable and requests that they be withdrawn. With regard to the § 101 rejection of claim 13, it is unclear to Applicant how the Examiner is interpreting "an electro-magnetic signal" as storing executable instructions, as does the computer readable medium recited in claim 13.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068 (or the undersigned).

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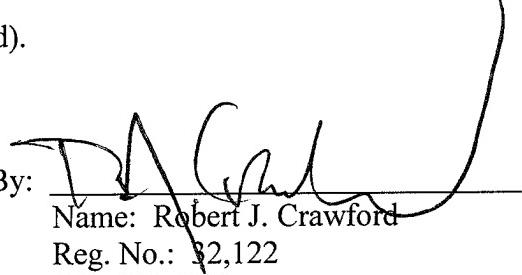
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